

1742



[10191/1438]

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : KNOLL et al.
Serial No. : 09/555,777
Filed : November 1, 2000
For : METHOD FOR PRODUCING COMPOSITE MATERIALS
AND EXAMPLES OF SUCH COMPOSITE MATERIALS

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GROUP 1700

Examiner : D. Jenkins
Group Art Unit : 1742
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Dated: 3/18/03
Reg. 41,172

Commissioner for Patents
Washington, D.C. 20231

Signature: D. Magist
DERVIS MAGISTRE
KENYON & KENYON

RESPONSE TRANSMITTAL

SIR:

Please find a Response transmitted herewith for filing in the above-identified patent application.

No fee is believed to be required. However, if any fee is required, please use Deposit Account No. 11-0600. A duplicate copy of this transmittal letter is enclosed for that purpose.

Respectfully submitted,

KENYON & KENYON

Dated: 3/18/03
By: Richard L. Mayer
Richard L. Mayer
Reg. No. 22,490

By: D. Magist (Reg. No. 41,172)
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Deriv Magistre
DERVIS MAGISTRE
KENYON & KENYON

RESPONSE

SIR:

In response to the Office Action dated January 2, 2003, reconsideration
and allowance of the above-referenced application are respectfully requested for the
reasons given below.

Remarks

Claims 28-47 and 49-54 remain pending in the above-referenced
application. Applicants note with appreciation the allowance of claims 47 and 49-54.

In explaining why he has maintained the rejection of claims 28-46
based on the prior art, the Examiner states that he "disagrees with Applicant's [sic]
position that the nitrogen partial pressure is not disclosed by Klemm." 2nd Office
Action at page 2. Respectfully, Applicants point out that the Examiner's statement is
an inaccurate characterization of their argument in the prior Amendment. What
Applicants did in fact state in this Amendment is "that Klemm does not identically

teach every limitation in the claim, as is required when a claim is to be properly rejected under Section 102, because Klemm does not teach both an upper and a lower limit of partial nitrogen pressures so that the silicon nitride is stable at the lower limit and the metal silicide is stable at the upper limit.” Amendment dated 10/11/02, at page 2. That Klemm does not teach all of the limitations in the establishing step of claim 28 is seen in the Figure, which pertains only to a nitrogen/temperature ratio stabilizing the metal silicide in the composite material. Column 2, lines 30-34. Since the Figure is relevant only to nitrogen/temperature ratios for metal silicides, it does not meet the claim limitation of “establishing, as a function of a sintering temperature,...a lower limit of partial nitrogen pressures so that the silicon nitride is stable at the lower limit... .” This deficiency in Klemm, and in the Figure thereof in particular, is evident from the absence of any plotted lines for the silicon nitride: all of the plotted lines are only for the metal silicides instead. Therefore, because of this deficiency in the Figure, Klemm does not teach establishing the lower limit recited in the claim. As for the Examiner’s belief that “[i]t is not necessary for Klemm to disclose upper and lower limits, but to merely provide nitrogen partial pressure within the range in order to anticipate the claim” (2nd Office Action at page 2), Applicants respectfully point out that it is not the role of the Examiner to sit in judgment over which claim terms should be examined and which need not be. The role of the Examiner is to examine all of a claim’s limitations, not just those he personally believes are significant. In re Wilson, 165 USPQ 494, 496 (CCPA 1970) (“[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.”). Therefore, unless the Examiner is able to find prior art teaching the establishing of the lower limit recited in claim 28, Applicants respectfully request that claim 28 be allowed.

As for claims 29-46, Applicants submit that these claims are patentable for at least the same reasons given in support of the patentability of claim 28.

Notwithstanding the above, Applicants submit the following additional reasons in support of the patentability of certain of the dependent claims.

With respect to claims 39-41, Klemm does not teach pre-sintering the parent substance prior to the step of gas pressure sintering. Unless the Examiner is able to specifically identify which portion of Klemm teaches this limitation, Applicants request withdrawal of the rejection of these claims.

Claim 43 recites that the step of gas pressure sintering is performed at partial nitrogen pressure of 0.5 MPa to 1.0 MPa. Of the nine examples discussed in Klemm, three (examples 2, 3, and 6) involve sintering, but none of them involve sintering within the recited pressure range. In particular, all three examples involve sintering at a pressure of 100 bars, which equals 10MPa. Since 10MPa is outside of the range recited in claim 43, withdrawal of this rejection is respectfully requested.

As for claims 44 and 45, nothing in Klemm shows the setting of the upper and lower limits according to the equations recited therein. Since the Examiner is required, as discussed above, to examine all of a claim's limitations, he is respectfully requested to either allow the claim or point out those portions of Klemm that teach these limitations.

Applicants assert that the present invention is new, non-obvious, and useful. Consideration and allowance of the claims are requested.

Respectfully submitted,

KENYON & KENYON

By: LO Magent (Reg. No. 41,172)

By: Richard L. Mayer
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Dated: 3/18/03

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